

REMARKS

Claims 1, 2, 4-10, 12-31, 33-37 and 39 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Finality of the Action:

The present action includes new grounds of rejection under 35 U.S.C. § 103(a) in regards to claims 15-25, 30, 31, 33-37 and 39 that were not necessitated by amendment. Therefore, per MPEP 706.07(a), the present action cannot be made final. Applicant notes that claims 15-25, 30, 31, 33-37 and 39 were not rejected in the last action, which was the first action after Applicant's request for continued examination. The present action is the first time claims 15-25, 30, 31, 33-37 and 39 have been rejected since Applicant filed the request for continued examination on August 14, 2008. Therefore, the rejection of these claims cannot be made final. Also, as noted below, the Examiner's basis for the rejection of these claims is based on a factually incorrect characterization of Applicant's arguments traversing the previous restriction requirement. Applicant requests withdrawal of the finality of the present Action pursuant to MPEP 706.07(a) and 706.07(d).

Section 112, Second Paragraph, Rejection:

The Examiner rejected claim 14 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. More specifically, the Examiner asserts that the limitations of claim 14 would be unclear to one of ordinary skill in the art. Applicant respectfully disagrees. The metes and bounds of claim 14 are clearly set forth by the claim limitations. For example, claim 14 recites "prevent[ing] rapid readout of the identifiers" in a specific manner, namely by "limiting the number of transactions performed during a given period of time." Nothing about "limiting the number of transactions performed during a given period of time," much less doing so to "prevent rapid readout of the identifiers" would be unclear to one of ordinary skill in the art.

Furthermore, the Examiner provides no substantive reasoning as to why the aforesaid limitations would be unclear to one of ordinary skill in the art. Instead, the Examiner questions “how” the “apparatus” would perform the claimed limitation. Applicant respectfully reminds the Examiner that claim 14 is a method claim, not an apparatus claim. Furthermore, claim 14 specifically sets forth “how” the manner in which “prevent[ing] rapid readout of the identifiers” is performed, namely by “limiting the number of transactions performed during a given period of time.” One of ordinary skill in the art would clearly understand the plain language of Applicant’s claim. Furthermore, as described above, the plain language of Applicant’s claim limitations clearly sets forth the metes and bounds of claim 14. Applicant reminds the Examiner that **“Breadth of a claim is not to be equated with indefiniteness.”** M.P.E.P. § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971) (emphasis added). For at least these reasons, Applicant asserts the Examiner’s rejection of claim 14 is improper and removal thereof is respectfully requested.

Section 103(a) Rejections:

The Examiner rejected claims 1, 2, 5, 7-10, 13 and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (U.S. Publication 2006/0218098) (hereinafter “Walker”) in view of Pitroda (U.S. Publication 2005/0247777), claims 4 and 12 as being unpatentable over Walker in view of Pitroda and further in view of Ritter et al. (U.S. Patent 6,934,689) (hereinafter “Ritter”), claim 6 as being unpatentable over Walker in view of Pitroda and further in view of Palomo et al. (U.S. Publication 2003/0120527) (hereinafter “Palomo”). Applicant respectfully traverses these rejections for at least the following reasons.

Claims 15-25, 30, 31, 33-37 and 39

No *prima facie* rejection has been stated for claims 15-25, 30, 31, 33-37 and 39. In the remarks regarding the now withdrawn restriction requirement (page 5 of Final Office Action), the Examiner asserts “[t]he restriction requirement is hereby withdrawn

because Applicant argues that invention II comprising claim 16 and invention III comprising claims 15, 17-25, 30-35, 36-37 and 39 are not patentably distinct from Invention I [defined by the Examiner as claims 1-8, 9-14, and 26-29]” and “[a]ccordingly, inventions II and III are rejected on the same rationale as invention I” (*see also*, Final Office Action, lines 1-2 of page 16). However, when traversing the restriction requirement Applicant did **NOT** argue that the different claims groups were not patentably distinct. Instead, Applicant’s traversal was based on the fact that the Examiner had not met the Examiner’s burden of establishing a proper restriction requirement. Just because Applicant noted that the Examiner had not stated a proper basis for restriction does not mean that Applicant argued that the different claim groups were not patentably distinct. In fact, in the traversal Applicant specifically noted that “there are differences in scope between independent claims of Invention I-III.” Applicant’s Response filed January 21, 2009. Therefore, because Applicant specifically did *not* argue that the claims groups were patentable indistinct, the Examiner cannot base the rejection of claims 15-25, 30, 31, 33-37 and 39 on Applicant’s traversal of the restriction requirement.

Since the Examiner did not address the actual limitations of claims 15-25, 30, 31, 33-37 and 39, which differ from the limitations of claims 1, 2, 4-10, 12-14 and 26-29, no *prima facie* rejection has been stated for these claims. For example, claim 16 recites a processor operable to randomly or pseudo-randomly select one identifier from said set of multiple identifiers for use in any transaction. None of claims 1, 2, 4-10, 12-14 and 26-29 include such a limitation (nor is such limitation taught by the cited references). Therefore, this limitation has not been addressed. Moreover, none of the cited references teach this aspect of Applicant’s claim.

Similar deficiencies exist in the Examiner’s rejection of other ones of claims 15-25, 30, 31, 33-37 and 39. For example, claim 17 recites “decrypting and validating the digital signature [of the transaction record] with a public key [received from the portable transaction device].” Because none of claims 1, 2, 4-10, 12-14 and 26-29 include such a limitation (nor is such limitation taught by the cited references), the Examiner has not

stated a proper rejection of claim 17 (much less established a *prima facie* case of obviousness of claim 17). In another example, claim 39 recites “means for accessing a digital signature comprised within the received transaction request and validating the digital signature.” Because none of claims 1, 2, 4-10, 12-14 and 26-29 include such a limitation (nor is such limitation taught by the cited references), the Examiner has not stated a proper rejection of claim 39 (much less established a *prima facie* case of obviousness of claim 39).

For at least the reasons presented above, the Examiner has not even attempted to state a *prima facie* rejection of claims 15-25, 30, 31, 33-37 and 39. Therefore, the rejection of these claims is improper.

Claim 1

In regard to claim 1, the cited art fails to teach or suggest wherein the apparatus is operable to, receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers, and transmit the transaction record to the terminal through the communications facility. The Examiner cites paragraphs [0089] and [0100] of Pitroda, none of which (even when considered in combination with Walker) teach or suggest the specific limitations of Applicant’s claim. In paragraph [0100], Pitroda discloses the following:

If the sales person is satisfied with the signature comparison, the sales person completes the transaction, and the CIU transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service. Those details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers), etc. (emphasis added)

The “details” described by the cited art (on which the Examiner presumably relies to teach Applicant’s claimed “transaction record”) do not include “a particular identifier

selected by the processor from said set of multiple identifiers” as recited in Applicant’s claim. In fact, neither Pitroda nor Walker, considered singly or in combination, teach or suggest anything about generating a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers, as recited in Applicant’s claim. Since the cited art fails to teach or suggest generating such a transaction record, the cited art cannot teach an apparatus configured to transmit such a transaction record to the terminal through the communications facility, as recited in claim 1.

In the response to arguments section of the Final Office Action mailed March 30, 2009, the Examiner appears to assert that he is, at least in part, relying on the phrase “American Express” mentioned in the cited portion of Pitroda (paragraphs 89 and 100) to teach the limitation “wherein the apparatus is operable to, receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from **said** set of multiple identifiers, and transmit the transaction record to the terminal through the communications facility.” As specified by the limitations of claim 1, **said** set of multiple identifiers are a set of multiple identifiers **“associated with a same customer account.”** In contrast to such limitation, Pitroda teaches a “UET” card that includes electronic versions of different credit cards and other types of accounts. It appears that the Examiner is relying on the different selectable electronic cards of Pitroda to teach the set of multiple identifiers of Applicant’s claim (*see e.g.*, page 3 of Final Office Action). It also appears that the Examiner is relying on the selection of an electronic “American Express” card to teach an identifier selected from the different selectable electronic cards of Pitroda (*see e.g.*, page 3 of Final Office Action). However, the selection of “American Express” is a selection of a particular account among multiple **different** accounts, not the selection of an identifier from multiple identifiers each associated with the **same** customer account. The Examiner’s interpretation directly contrasts with claim 1 which recites “generating a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple

identifiers” where said set of multiple identifiers are “associated with a same customer account.” Accordingly, the cited references (considered singly or in combination) fail to teach or suggest the specific limitations of Applicant’s claim.

Furthermore, in regard to the Examiner remarks regarding intended use (*see e.g., page 3, section 5 of the Final Office Action*), Applicant notes that various instances of “operable to” in Applicants’ claims accompany language that recites specific limitations of the corresponding element. In other words, the claims describe that the claim elements are physically operable to perform a certain function or have certain properties. An “operable to” limitation at least requires the ability to perform the stated function. Thus, to teach such a limitation the prior art would have to describe an object that at least had the same ability. The use of functional limitations to define an invention has been expressly approved by the courts. *See, e.g., In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In fact, the Court has held that a functional claim limitation can distinguish over the prior art “because it set definite boundaries on the patent protection sought.” *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Since the cited references (considered singly or in combination) fail to teach an apparatus configured in the same manner as the apparatus of claim 1, the cited art fails to teach or suggest the specific limitations of claim 1

Furthermore, Applicant’s assert the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have combined the teachings of the cited references to create Applicant’s invention as claimed. The Examiner asserts that it would have been obvious to modify Walker with the teachings of Pitroda “since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would [sic] have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.” The Examiner’s reasoning is circular and conclusory. More specifically, the Examiner’s assertion that “the claimed invention is merely a combination of old and known elements” is not supported by any **actual evidence of record** since Pitroda and Walker fail to teach or suggest all

limitations of Applicant's claim, as described above. **The Examiner fails to provide any substantive response to this argument in the Final Office Action.**

Thus, for at least the reasons presented above, the rejection of claim 1 is unsupported by the teachings of cited art and removal thereof is respectfully requested. Similar remarks apply to claims 9 and 26.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicants reserve the right to present additional arguments.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-20500/RCK.

Respectfully submitted,

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